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United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 60282.00039
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 09/893,028 Filed: June 27, 2001 First Named Inventor: Paul KARLSTEDT Art Unit: 2687 Examiner: Un C. Cho

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 54,749

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703-720-7898

Telephone number

January 19, 2006

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Paul KARLSTEDT et al.

Art Unit: 2687

Application No.: 09/893,028

Examiner: Un C. Cho

Filed: June 27, 2001

Attorney Dkt. No.: 60282.00039

For: METHOD FOR GENERATION AND TRANSMISSION OF MESSAGES IN A MOBILE
TELECOMMUNICATION NETWORK

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 19, 2006

Sir:

Applicants respectfully request a review of the final rejections set forth in the final Office Action dated November 2, 2005, finally rejecting claims 21-26 and 29-34. Applicants submit that a prima facie case for obviousness has not been established, and that there is clear error with regard to at least one element of each of the independent claims.

The final Office Action rejected claims 21, 25, and 29-34 under 35 U.S.C. §103(a) as being unpatentable over Syed (U.S. Patent No. 6,038,451) in view of Segal (U.S. Patent No. 6,124,810). The Office Action took the position that Syed discloses all of the elements of the claims, with the exception of "if the result of judging is positive, sending a predetermined voice or data message from said network to another terminal, wherein said another terminal is a predetermined subscriber terminal; and defining said predetermined terminal as a terminal which has issued a request for a value added service." The Office Action then relies upon Segal as allegedly curing these deficiencies in Syed. Applicants respectfully submit that there is clear error in that the combination of Syed and Segal fails to disclose or suggest all of the elements of the presently pending claims.

According to embodiments of the present invention, by automatically initiating a generation and transmission of a message from a mobile network dependent on the location of a mobile subscriber terminal, the peak traffic load for the mobile access network at specific times can be reduced. It may be assumed that the mobile subscribers move in different directions for different distances, and consequently require different times until they are close to a respective predetermined location, such as their home. Thus, transmissions of messages, which were traditionally effected at substantially the same time, are now, according to the present invention, established at different times, when the respective subscriber terminal reaches a respective predetermined location (group of cells) within the network. This leads to a distribution of the peak traffic load occurring in the mobile network over a certain period of time, thereby reducing and/or averaging the traffic load. As a result, no additional traffic capacities for the mobile network need to be provided in order to cope with such peak traffic loads. In other words, no additional radio resource communications are used, since a switching center as a part of a mobile network can send the message dependent on the detection of the predetermined location information.

Applicants respectfully submit that the present claims recite subject matter which is neither disclosed nor suggested by the cited prior art discussed above, and that, therefore, the final rejections are improper and without basis. For example, the present claims are directed, in part, to a method for generation and transmission of messages in a mobile telecommunication network. Applicants respectfully submit that Syed does not disclose or suggest generating any messages in a telecommunication network. Rather, Syed merely forwards calls which are not generated in the network but actually generated by a terminal. Segal also fails to disclose or suggest generating a message in a mobile telecommunication system.

Furthermore, the Office Action acknowledges that Syed fails to disclose or suggest "if the result of judging is positive, sending a predetermined voice or data message from said network to another terminal, wherein said another terminal is a predetermined subscriber terminal; and defining said predetermined terminal as a terminal which has issued a request for a value added service." The Office Action alleges that Segal discloses this element of the claims. Applicants respectfully disagree. More specifically, Applicants submit that the combination of Syed and

Segal fails to disclose or suggest that the predetermined voice or data message is sent from the network to another terminal, as recited in the claims.

Segal, as discussed above, discloses a method and apparatus for automatic event detection in a wireless communication system. The event is detected using a processor onboard the vehicle (or terminal). Upon detection of an event, the processor generates an indication of the event and provides the indication to the central facility, to the vehicle operator, or both (Segal, Column 2, lines 56-67). As such, according to Segal, the terminal, i.e. processor onboard the vehicle, is providing the indication or message. Consequently, according to Segal, the predetermined voice or data message is not sent from the network, but from the terminal whose location is being monitored. Therefore, Segal, like Syed, fails to disclose or suggest that “if the result of judging is positive, **sending a predetermined voice or data message from said network to another terminal**, wherein said another terminal is a predetermined subscriber terminal; and defining said predetermined terminal as a terminal which has issued a request for a value added service.” Accordingly, the combination of Syed and Segal fails to disclose or suggest at least this element of claim 21.

Moreover, according to the configuration disclosed in Segal, the transmission of messages from the terminals being monitored is increased. The present invention, on the other hand, expressly seeks to avoid such a drawback. As such, according to embodiments of the present invention, the monitored terminal is not involved in any communication when it is judged that the monitored location of the terminal corresponds to a predetermined location.

Furthermore, although the processor of Segal may generate an indication to the central facility and although such a central facility may be regarded as a predetermined terminal, which is not admitted, it is respectfully asserted that the central facility of Segal does not issue a request for such value added service. Therefore, Applicants submit that Segal, like Syed, fails to disclose or suggest “defining the predetermined terminal as a terminal which has issued a request for a value added service,” as recited in claim 21. Segal specifically discloses that each dispatch center, as a central facility, is able to communicate with their corresponding fleet of vehicles (Segal, Column 4, lines 20-23). In addition, each dispatch center/central facility is known beforehand to the respective vehicles carrying a processor and other means described therein. Hence, the central facility need not request any service from the vehicle or processor, rather the

monitored vehicle is preconfigured so as to generate and send the indication, if any, to the central facility of the fleet of vehicles to which it belongs. For at least the reasons discussed above, Applicants respectfully submit that Syed and Segal, whether considered alone or combined, fail to disclose or suggest that the predetermined terminal is a terminal which has issued a request for a value added service, as recited in claim 21.

Additionally, embodiments of the present inventions seek to reduce peak traffic load in the mobile access network while also improving value added services available in a telecommunication network. These aims cannot be achieved by the arrangement disclosed in Segal. For example, assuming that a plurality of vehicles carrying a system and processor, as disclosed in Segal, stop at the same point in time in order to comply with government regulations (see Segal, Column 10, lines 39-44), each of the respective vehicles will generate an indication to their respective central facility. This will result in a corresponding number of indications transmitted by the mobile communication network and will result in an increase in the traffic load in the mobile access network used for transmitting the indications from the processors of the vehicles to the central facility. The present invention, on the other hand, removes such drawbacks by changing the location of the generation of the messages and transfers the generation of such messages to a network entity. Furthermore, the messages are not transmitted to a fixed and predetermined point but to an arbitrarily definable terminal in that a terminal which has issued a request for such a value added service may receive such a predetermined voice or data message.

Therefore, as discussed above, the combination of Syed and Segal fails to disclose or suggest “if the result of judging is positive, **sending a predetermined voice or data message from said network to another terminal**, wherein said another terminal is a predetermined subscriber terminal; and **defining said predetermined terminal as a terminal which has issued a request for a value added service**,” as recited in claim 21.

Claims 25 and 29-34 are dependent upon claim 21. As such, claims 25 and 29-34 should be allowed for at least their dependence upon claim 21, and for the specific limitations recited therein.

Claims 22-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Syed in view of Segal and further in view of Stenman (U.S. Patent No. 6,223,029). Claims 22-24 are

dependent upon claim 21. As discussed above, the combination of Syed and Segal does not disclose or suggest all of the elements of claim 21. Furthermore, Stenman fails to cure the deficiencies in Syed and Segal, as Stenman also fails to disclose or suggest "if the result of judging is positive, **sending a predetermined voice or data message from said network to another terminal**, wherein said another terminal is a predetermined subscriber terminal; and **defining said predetermined terminal as a terminal which has issued a request for a value added service.**" Therefore, the combination of Syed, Segal and Stenman does not render claims 22-24 as obvious. Additionally, claims 22-24 should be allowed for at least their dependence upon claim 21, and for the specific limitations recited therein.

Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Syed in view of Segal and further in view of Brennan (U.S. Patent No. 5,329,578). Applicants respectfully submit that claim 26 is also dependent upon claim 21. In addition, Brennan, like Stenman, fails to cure the deficiencies in Syed and Segal with respect to claim 21. Therefore, the combination of Syed, Segal and Brennan fails to disclose or suggest all of the elements of claim 26. As a result, claim 26 should be allowed for at least its dependence upon claim 21, and for the specific limitations recited therein.

Applicants respectfully assert that there is clear error in that the Office Action has failed to establish a prima facie rejection for obviousness, as the combination of the cited references do not disclose or suggest all of the elements of the presently pending claims. It is therefore respectfully requested that all of claims 21-26 and 29-34 be allowed, and this application passed to issue.

In the event that any additional fees are due with respect to the filing of this paper, Applicants request that any deficiency be charged to Counsel's Deposit Account 50-2222.

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